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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,033	08/21/2001	Alexander Rothacker	28655/37222	7797

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EXAMINER

NGUYEN, TAM M

ART UNIT PAPER NUMBER

3764

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,033

Applicant(s)

ROTHACKER, ALEXANDER

Examiner

Tam Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 7 and 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 4-6, 8-11 and 15-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speyer (3,825,253) in view of Heiman (4,685,675), Webber et al. (6,193,635), Rennex (4,971,305), Wendt (4,602,788) and in further view of Choice 1 Medical Distributors website ("Choice1").

1. As to claims 4-6, Speyer discloses an incremental weight training apparatus comprising a barbell and a set of standard free weights. Speyer does not disclose an incremental weight in the range of one quarter-ounce weight to thirty two-ounce weight. Heiman discloses an exercise device that utilizes add-on weights in increments of 1/8 of an ounce (see Col. 4, lines 38-44 & Fig. 1), Webber discloses a weight stack apparatus that includes incremental weights of 5 pounds or less (see Col. 6, lines 30-34), Rennex discloses an exercise device that utilizes finely incremental add-on weights that may include weights as little as 4 ounces (see Col. 3, lines 9-12 and Col. 4, lines 30-34), Wendt discloses an exercise device that utilizes weight plates of various sizes weighing 1, 2, 4, 8, and 16 ounces, and Choice 1 discloses a 32 ounce weight for exercise (see website c1md.com). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make Speyer's weight plates into any of an array of

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sizes from 1/8 of an ounce up through 45 pounds since the use of such a range of sizes is well known in the exercise art as shown by the representative references cited above and the practice of incrementally adding weight plates of various sizes during exercise is well known in the art.

2. As to claims 15-20, Speyer discloses an incremental weight system and inherently a method for exercising as substantially claimed wherein the system comprises a plurality of weights having a slot adapted to receive a weight bearing cable and a center opening adapted to receive a standard barbell (see Fig. 3). Speyer does not disclose the specific sized weight plates as claimed. Heiman, Webber, Rennex, Wendt and Choice 1 disclose the use of weights having various sizes between 1/8 ounce and 32 ounces. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make weight plates into any of an array of sizes within that range since the use of such a range of weights is well known in the exercise art.

Claims 8-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Webber et al. (6,193,635), in view of Heiman (4,685,675), Rennex (4,971,305), Wendt (4,602,788) and in further view of Choice 1 Medical Distributors website ("Choice1").

3. As to claims 8-11, Webber discloses an incremental weight system comprising a cable type weight training apparatus and a plurality of weights having a center opening and a slot as substantially claimed (see Col. 6, lines 34-44, Col. 7, lines 24-26 & Fig. 11). Webber does not disclose that the weights are in the range of one quarter-ounce to 32 ounces. Heiman discloses an exercise device that utilizes add-on weights in

increments of 1/8 of an ounce (see Col. 4, lines 38-44 & Fig. 1), Webber discloses a weight stack apparatus that includes incremental weights of 5 pounds or less (see Col. 6, lines 30-34), Rennex discloses an exercise device that utilizes finely incremental add-on weights that may include weights as little as 4 ounces (see Col. 3, lines 9-12 and Col. 4, lines 30-34), Wendt discloses an exercise device that utilizes weight plates of various sizes weighing 1, 2, 4, 8, and 16 ounces, and Choice 1 discloses a 32 ounce weight for exercise (see website c1md.com). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make Webber's add-on plates into any of an array of sizes as substantially claimed since the use of such a range of sizes is well known in the exercise art as shown by the representative references cited above and the practice of incrementally adding weight plates of various sizes during exercise is well known in the art.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Additionally, applicant's arguments filed April 28, 2005 have been fully considered but they are not persuasive. The prior art clearly discloses the use of add-on weights as small as 1/8 of an ounce which covers the instant invention's range of incremental weights having a range of 1/4 ounce up to 32 ounces. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make add-on weight plates, having such weights, usable with a barbell or cable type weight apparatus since the use of such weights on a variety of exercise equipment is well known in the exercise art.

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Furthermore, applicant has merely decreased the size of traditional weight plates.

Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. In re Dreyfus, 22 CCPA (Patents) 830, 73 F.2d 931, 24 USPQ 52; In re Waite et al., 35 CCPA (Patents) 1117, 168 F.2d 104, 77 USPQ 586. Such ranges are termed "critical" ranges, and the applicant has the burden of proving such criticality. In re Swenson et al., 30 CCPA (Patents) 809, 132 F.2d 1020, 56 USPQ 372; In re Scherl, 33 CCPA (Patents) 1193, 156 F.2d 72, 70 USPQ 204. However, even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. In re Sola, 22 CCPA (Patents) 1313, 77 F.2d 627, 25 USPQ 433; In re Normann et al., 32 CCPA (Patents) 1248, 150 F.2d 627, 66 USPQ 308; In re Irmscher, 32 CCPA (Patents) 1259, 150 F.2d 705, 66 USPQ 314. More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et al., 33 CCPA (Patents) 1250, 156 F.2d 239, 70 USPQ 412; Minnesota Mining and Mfg. Co. v. Coe, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; Allen et al. v. Coe, 77 App. D.C. 324, 135 F.2d 11, 57 USPQ 136.

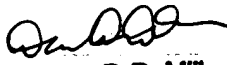
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam Nguyen whose telephone number is 571-272-4979. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 571-272-4778. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 26, 2005


Danton D. DeMille
Primary Examiner